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EXAMINER	
PATEL, DHIRUBHAI R	

ART UNIT	PAPER NUMBER
2831	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/764,572	ACKERMAN ET AL.	
	Examiner	Art Unit	
	DHIRU R PATEL	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-27,37,38 and 40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-27,37,38 and 40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Part III DETAILED ACTION

1. The finality of the final rejection mailed on 5/06/2004 is hereby vacated to clarify the rejections to claims 23-27, 37-38 and 40. This office action replaces previously office action sent on 5/06/04 with a new statutory period. Any inconvenience to the Applicant is regretted.

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The applicant has failed to provide the following :

For claim 23: a method of assisting a compromised barrier comprising : placing the fire retardant gasket between a faceplate and an electrical box, coupling the faceplate to the box, and at least partially reestablishing a fire rating of the barrier.

For claim 37, a method of assisting a compromised barrier comprising: installing into a fire rated barrier an electrical box, introducing into the electrical box a fire retardant gasket, and covering the electrical box with a faceplate .

It is noted that a declaration does not provide the claimed subject matter for claims 23 and 37. Exhibit A for E -mail and discussed about "gasket" for cover plates, but did not provide any information about a gasket comprising fire retardant material of a fire resistant insulative

material containing mineral wool or intumescent graphite as claimed in claim 23 and 37, Exhibit B discussed about an electrical box only, but did not provide placing the fire retardant gasket between a faceplate and an electrical box for claim 23 .Exhibit C discussed about metal size only, and Exhibit D discussed about a plate , a box, hole and cold face, but did not provide claimed subject matter for claims 23 and 37, and Exhibit E testing of 1.5mm blazeseal electrical plate covers only. Exhibits A through E are insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23 line 8, " at least partially reestablishing a fire rating of the barrier" is confusing and unclear in light of the specification. What is at least partially reestablishing a fire rating of the barrier?.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-27, 37-38, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Dykhoff et al (6,521,834).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 23, a method of assisting a compromised barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50,column 4 lines 30-40, column 14 lines 45-55) comprising:

a) providing a gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) comprising fire retardant material of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67,

column 9 lines 23-30, column 11 lines 24-67, column 12 lines 1- 24) containing **an intumescent graphite** (see abstract lines 11-14, column 9 lines 3- 30, please note that the fire stopping mat include an intumescent compound);

b) placing the fire retardant gasket 8 between a faceplate 6 and an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, see column 4 lines 30-53, column 14 lines 38-55) adapted to be introduced into the barrier 4 (see fig 1, column 3 lines 20-50, column 4 lines 30-60, column 14 lines 45-52);

c) coupling the faceplate 6 to the box 10 (see fig 1 , column 3 lines 40-50, column 4 lines 30-54, column 15 lines 1-5) ;

and d) at least partially reestablishing a fire rating of the barrier (see column 1 lines 15-35, column 2 lines 20-26, column 3 lines 5-50, column 4 lines 54-62, column 14 lines 45-52).

Regarding claim 24 , the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising coupling the gasket 8 in situ between the faceplate 6 and the box 10 (see fig1, column 3 lines 30-50, column 4 lines 30-62, column 16 lines 10-16).

Regarding claim 25 , the assembly of Dykhoff et al disclose all of the claimed features as shown above, including providing the gasket 8 comprises forming the gasket 8 as a separate element (see fig 1, column 3 lines 40-50, column 4 lines 35-40, column 16 lines 10-16) prior to placing the gasket 8 between the

faceplate 6 and the box 10 (see fig1, column 4 lines 30-50 and column 16 lines 10-16).

Regarding claim 26 , the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising forming the gasket 8 on one surface of the faceplate 6 prior to coupling the faceplate 6 to the box 10 (see column 3 lines 40-50, column 4 lines 54-62, column 16 lines 10-16).

Regarding claim 27, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the gasket is being formed by establishing a coating of the fire retardant material onto the faceplate 6 (see column 2 lines 29-35, column 3 lines 40-45, column 15 lines 1-14).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 37, a method of assisting a compromised barrier (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46,column 3 lines 40-50,column 4 lines 30-40, column 14 lines 45-55) comprising:

a) installing into a fire rated barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-12, column 2 lines 40-46, column 3 lines 40-50,column 4 lines 30-40, column 14 lines 45-55) an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, column 4 lines 40-45, column 14 lines 38-55) , the electrical box 10 compromising the fire resistance of the fire rated barrier (see

column 1 lines 5-40, column 2 lines 1-28,column 3 lines 40-50, column 4 lines 30-45),

b) introducing into the electrical box 10 a fire retardant gasket 8 (a fire stopping mat, see fig 1,column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 20-30, column 11 lines 24-67, column 12 lines 1- 24)containing **an intumescent graphite** (see abstract lines 11-14, column 9 lines 3- 30, please note that the fire stopping mat include an intumescent compound) ; and covering the electrical box 10 with a faceplate 6 (see fig 1, column 2 lines 1-10, column 3 lines 40-45, column 4 lines 30-54, column 14 lines 40-55).

Regarding claim 38, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being adhered to the faceplate 6 prior to covering the electrical box 10 with the faceplate 6 (see column 2 lines 1-10, column 3 lines 40-50, column 14 lines 40-50, column 16 lines 10-18).

Regarding claim 40, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being introduced to the electrical box 10 without removing the electrical box 10 from the fire resistant barrier (see fig 1, column 2 lines 10-40, column 3 lines 30-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 23-27 and 37-38,40 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Dykhoff et al (6,521,834) in view of Landin (6,153,674).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 23, a method of assisting a compromised barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50,column 4 lines 30-40, column 14 lines 45-55) comprising:

a) providing a gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) comprising fire retardant material of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 23-30, column 11 lines 24-67, column 12 lines 1- 24) containing an intumescent graphite (see abstract lines 11-14, column 9 lines 3-30);

b) placing the fire retardant gasket 8 between a faceplate 6 and an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, see column 4 lines 30-53, column 14 lines 38-55) adapted to be introduced into the barrier 4 (see fig 1, column 3 lines 20-50, column 4 lines 30-60, column 14 lines 45-52);

c) coupling the faceplate 6 to the box 10 (see fig 1 , column 3 lines 40-50, column 4 lines 30-54, column 15 lines 1-5) ; and

d) at least partially reestablishing a fire rating of the barrier (see column 1 lines 15-35, column 2 lines 20-26, column 3 lines 5-50, column 4 lines 54-62, column 14 lines 45-52), but fails to disclose said fire resistant insulative material containing mineral wool. Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1

lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62). It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool **as evidence by Landian**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Dykhoff et al with a fire resistant insulative material containing mineral wool as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses, and it has been held to be within the general skill of a worker in the art to select a known material on

the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 24 , the modified assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising coupling the gasket 8 in situ between the faceplate 6 and the box 10 (see fig1, column 3 lines 30-50, column 4 lines 30-62, column 16 lines 10-16 of Dykhoff et al).

Regarding claim 25 , the modified assembly of Dykhoff et al disclose all of the claimed features as shown above, including providing the gasket 8 comprises forming the gasket 8 as a separate element (see fig 1, column 3 lines 40-50, column 4 lines 35-40, column 16 lines 10-16 of Dykhoff et al) prior to placing the gasket 8 between the faceplate 6 and the box 10 (see fig1, column 4 lines 30-50 and column 16 lines 10-16 of Dykhoff et al).

Regarding claim 26 , the modified assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising forming the gasket 8 on one surface of the faceplate 6 prior to coupling the faceplate 6 to the box 10 (see column 3 lines 40-50, column 4 lines 54-62, column 16 lines 10-16 of Dykhoff et al).

Regarding claim 27, the modified assembly of Dykhoff et al disclose all of the claimed features as shown above, including the gasket is being formed by establishing a coating of the fire retardant material onto the faceplate 6

(see column 2 lines 29-35, column 3 lines 40-45, column 15 lines 1-14 of Dykhoff et al).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 37, a method of assisting a compromised barrier (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46,column 3 lines 40-50,column 4 lines 30-40, column 14 lines 45-55) comprising:

a) installing into a fire rated barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-12, column 2 lines 40-46, column 3 lines 40-50,column 4 lines 30-40, column 14 lines 45-55) an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, column 4 lines 40-45, column 14 lines 38-55) , the electrical box 10 compromising the fire resistance of the fire rated barrier (see column 1 lines 5-40, column 2 lines 1-28,column 3 lines 40-50, column 4 lines 30-45),

b) introducing into the electrical box 10 a fire retardant gasket 8 (a fire stopping mat, see fig 1,column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 20-30, column 11 lines 24-67, column 12 lines 1- 24) containing an intumescent graphite (see abstract lines 11-14, column 9 lines 3-30) ; and covering the electrical box 10 with a faceplate 6 (see fig 1, column 2 lines 1-10,

column 3 lines 40-45, column 4 lines 30-54, column 14 lines 40-55), but fails to disclose said fire resistant insulative material containing mineral wool. Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62). It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool **as evidence by Landian**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Dykhoff et al with a fire resistant insulative material containing mineral wool as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the

barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses, and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 38, the modified assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being adhered to the faceplate 6 prior to covering the electrical box 10 with the faceplate 6 (see column 2 lines 1-10, column 3 lines 40-50, column 14 lines 40-50, column 16 lines 10-18 of Dykhoff et al).

Regarding claim 40, the modified assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being introduced to the electrical box 10 without removing the electrical box 10 from the fire resistant barrier (see fig 1, column 2 lines 10-40, column 3 lines 30-50 of Dykhoff et al).

6. Claims 23-27 and 37-38,40 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Close Jr (4,163,137) in view of Landin (6,153,674). Assembly of the device of Close comprises the method steps of:

Regarding claim 23, a method of assisting a compromised barrier (a wall, see the entire column 3 and the column 4 and column 6 lines 5-10) comprising: a) providing a gasket 70, 70', 90 (see figs 2-5 and fig 7, column 1 lines 8-12, column 3 lines 40-60, column 4 lines 1-35) comprising fire retardant material of a fire resistant insulative material (**please note that Close disclosed a gasket for sealing around said opening to prevent passage of air, said gasket comprising a thin sheet of flexible material, said sheet being formed of plastic material having flame retardant properties, see column 6 lines 19-35 as well as sheet 98 is preferably formed of suitable plastic material having fire retardant properties, see column 5 lines 40-45**): b) placing the fire retardant gasket 70, 70' between a faceplate 50,50' and an electrical box 28 (see figs 3 and 7, column 2 lines 1-5, and the entire column 3) adapted to be introduced into the barrier (see figs 3 and 7 and the entire column 3); c) coupling the faceplate 50, 50' to the box 28 (see figs 3 and 7 and the entire column 3 and the entire column 5) ; and d) at least partially reestablishing a fire rating of the barrier (see the entire column 3 and the entire column 6), but fails to disclose the fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite.

Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62).

It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as evidence by **Landian**, and **please note that Close disclosed a gasket for sealing around said opening to prevent passage of air, said gasket comprising a thin sheet of flexible material, said sheet being formed of plastic material having flame retardant properties, see column 6 lines 19-35 as well as sheet 98 is preferably formed of suitable plastic material having fire retardant properties, see column 5 lines 40-45**). It would have

been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses , and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 24 , the modified assembly of Close disclose all of the claimed features as shown above, including coupling the gasket 70, 70' (see figs 3 and 7 of Close) in situ between the faceplate 50, 50' and the box 28 (see figs3 and 7 of Close).

Regarding claim 25 , the modified assembly of Close disclose all of the claimed features as shown above, including the gasket 70, 70' comprises forming the gasket 70, 70' as a separate element (see fig3 and 7 of Close) prior to placing

the gasket 70, 70' between the faceplate 50,50' and the box 28 (see figs 3-4 and 7 of Close).

Regarding claim 26 , the modified assembly of Close disclose all of the claimed features as shown above, including forming the gasket 70, 70' on one surface of the faceplate 50,50' prior to coupling the faceplate 50, 50' to the box 28 (see figs 3 and 7 of Close).

Regarding claim 27, the modified assembly of Close disclose all of the claimed features as shown above, including the gasket 70, 70' is being formed by establishing a coating of the fire retardant material onto the faceplate 50, 50' (see the entire column 3 and 5 of Close).

Close disclose:

Assembly of the device of Close comprises the method steps of:

Regarding claim 37, a method for assisting a compromised barrier (a wall, see the entire column 3 and column 4 and column 6 lines 5-10) comprising:

a) installing into a fire rated barrier (a wall,see the entire column 3 and column 4 and column 6 lines 5-10) an electrical box 28 (see figs 3,7 and the entire column 3) , the electrical box 28 compromising the fire resistance of the fire rated barrier (see the entire specification),

b) introducing into the electrical box 28 a fire retardant gasket 70, 70', 90 ((see figs 2-5 and 7, column 1 lines 8-12, column 3 lines 40-60, and the entire column 5); and covering the electrical box 28 with a faceplate 50, 50'(see figs3,7 and the entire column 3 and the column 6), but fails to disclose the fire retardant gasket of a fire resistant insulative material containing mineral wool or intumescent graphite.

Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62).

It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as

evidence by Landian.(**please note that Close disclosed a gasket for sealing around said opening to prevent passage of air, said gasket comprising a thin sheet of flexible material, said sheet being formed of plastic material having flame retardent properties, see column 6 lines 19-35 as well as sheet 98 is preferably formed of suitable plastic material having fire retardant properties, see column 5 lines 40-45**). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses , and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 38, the modified assembly of Close disclose all of the claimed features as shown above, including the fire retardant gasket being adhered to

the faceplate prior to covering the electrical box with the faceplate (see fig 3 and the entire specification of Close).

Regarding claim 40, the modified assembly of Close disclose all of the claimed features as shown above, including the fire retardant gasket being introduced to the electrical box without removing the electrical box from the fire resistant barrier (see fig 3, and the entire specification of close).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

8. Applicants' arguments with respect to claims 23-27, 37-38, 40 have been considered but are moot in view of the new ground(s) of rejection.

Further, the DECLARATION under 37 CFR 1.131 filed dated 3/30/04 is insufficient to overcome the rejection of claims 23-27, 37-38, 40 based upon anticipated by Dykhoff et al reference, and Dykhoff et al in view of Landin reference and Close reference in view of Landin reference as set forth in the current Office action as mentioned above. With respect to applicants' arguments on page 7 that " In any event, applicants' claims have been amended to specifically recite only the fire resistant insulative material as intumescent graphite or mineral wool, and neither of these materials being disclosed in Dykhoff. Dykhoff therefore cannot anticipate the claimed invention of applicants . **The examiner is respectfully disagrees because Dykhoff clearly disclosed that the gasket (fire stopping mat) may include an intumescent compound and the intumescent compounds include intumescent graphite (see the entire abstract and column 9 lines 3-30 of Dykhoff)**, With respect to applicants' arguments on page 9 that " at least partially reestablishing a fire rating of the barrier." i.e. partially or fully reestablishing a fire rating of 1,2,3, or 4 hours, and " one of skill in the art would recognize that barriers typically exhibit

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maximum fire ratings of 1,2,3 or 4 hours..... wether those skilled in the art would understand the scope of the claim when the claim is red in light of the rest of the specification". The examiner is respectfully disagrees because **the specification must disclosed the definition of at least partially reestablishing a fire rating of the barrier** in order for those skilled in the art to understand the scope of the claim when the claim is red in light of the rest of the specification, further applicants' argues that barriers typically exhibit maximum fire ratings of 1,2,3 or 4 hours. **It is noted that the specification does not disclosed** barriers typically exhibit maximum fire ratings of 1,2,3 or 4 hours.

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Contact information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Dhiru Patel
Primary Examiner
Group Art Unit 2831
September 20, 2004

Dhiru R Patel 9/20/04
DHIRU R. PATEL
PRIMARY EXAMINER